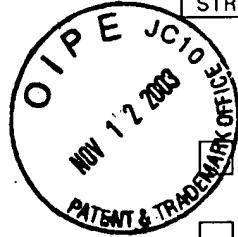


AF/1772

TRANSMITTAL LETTER			Case No. 659/489	KC Ref No. 13,823/14,370
Serial No. 09/215,951	Filing Date December 18, 1998	Examiner A. Chevalier	Group Art Unit 1772	
Inventor Fell et al.				RECEIVED NOV 17 2003 TC 1700
Title of Invention STRETCHABLE COMPOSITE MATERIAL HAVING CONTINOUS GATHERS				



## TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is Transmittal Letter (in duplicate); Reply Brief; Return Postcard.

Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.

A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27 is enclosed.

Petition for a 1 month extension of time.

No additional fee is required.

The fee has been calculated as shown below:

	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra
Total	14	Minus	20	0
Indep.	7	Minus	7	0
First Presentation of Multiple Dep. Claim				

Small Entity		or	Other Than Small Entity	
Rate	Add'l Fee		Rate	Add'l Fee
X \$9 =			x \$18 =	
X 40 =			x \$80 =	
+ \$135 =			+ \$270 =	
	Total add'l fee	\$		Total add'l fee \$

Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$ \_\_\_\_\_. A duplicate copy of this sheet is enclosed.

A check in the amounts of \$ \_\_\_\_ to cover the filing fees are enclosed.

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Glen P. Belvis  
Registration No. 31,735  
Representative for Applicant

BRINKS HOFER GILSON & LIONE  
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CHICAGO, ILLINOIS 60610  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on November 10, 2003.

Date: 11/10/03 Signature: Glen P. Belvis  
Dec.-00  
C:\GPB\PATENT\659-482-Transmittal Letter with Appeal and Response.doc

I hereby certify that this correspondence is being deposited with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
on November 10, 2003

Date of Deposit

*Glen P. Belvis*

Name of applicant, assignee or  
Registered Representative

*Glen P. Belvis*

Signature

*11/10/03*

Date of Signature

In re Application of:

Fell et al.

Serial No.: 09/215,951

Filing Date: December 18, 1998

For STRETCHABLE COMPOSITE  
MATERIAL HAVING CONTINUOUS  
GATHERS

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Examiner: A. Chevalier

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Group Art Unit No. 1772

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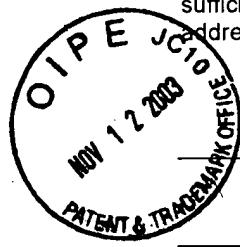
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## REPLY BRIEF

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Examiner's Answer dated September 10, 2003.



RECEIVED  
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TC 1700  
#318103

Our Case No. 659/489

KC Ref. No. 13,823/14,370

## ISSUES

1. Whether Claims 1, 3, 5-9, 15, 17, 18, and 48-50 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent 3,371,668 to Johnson.
2. Whether Claims 1, 2, 4, 6-9, 15, 17, and 18 are anticipated under 35 U.S.C. § 102(b) or rejected over 35 U.S.C. § 103(a) by U.S. Patent 5,209,801 to Smith.
3. Whether Claims 1, 3, and 15-18 are anticipated under 35 U.S.C. § 102(b) or rejected over U.S. Patent 5,706,524 to Herrin et al.
4. Whether Claims 1, 2, 4, 6-9, 15, 17, and 18 are unpatentable under 35 U.S.C. § 103(a) over Smith in view of U.S. Patent 4,720,415 to Vander Wielen et al.
5. Whether Claims 1, 3, and 5-18 are unpatentable under 35 U.S.C. § 103(a) over Herrin et al. in view of Vander Wielen et al.
6. Whether Claims 2 and 4 are unpatentable under 35 U.S.C. § 103(a) over Johnson or Herrin et al. in view of Smith.
7. Whether Claims 10-14 and 16 are unpatentable under 35 U.S.C. § 103(a) over Johnson in view of U.S. Patent 5,843,066 to Dorbin.

## REPLY TO EXAMINER'S ANSWER

This case now appears to have evolved into a claims interpretation dispute between the Examiner and Applicants. Under Applicants' construction, the Examiner essentially concedes that the claimed ratio – "a maximum elongation of at least about 85% of the elongation of the elastic member" – is not found in the prior art. Under Applicants' construction, the Examiner further appears to concede that there is no suggestion in the prior art to combine elements to obtain the claimed composite material having this ratio. Moreover, even under the Examiner's proposed hindsight combination of references the claimed ratio is absent.

Recognizing that the prior art does not teach or suggest Applicants' claimed ratio, the Examiner attempts to put forward a theoretical construction for the claimed ratio to support the rejection of the claims. This theoretical construction, however, fails for several reasons.

First, the Examiner never articulates the metes and bounds of this theoretical construction, how this construction can be reconciled with the other elements of the claims, and how the prior art allegedly reads on or renders such a claim unpatentable. The Examiner's theoretical construction is at most a "wish." Moreover, it is a "wish" that fails to provide any boundaries under which to evaluate the prior art. In short, the

Examiner's "wish" that some theoretical and unarticulated claim reads on the prior art is not a proper basis to deny Applicants a patent.

Second, the Examiner provides **no** support for her theoretical and unarticulated construction. To the contrary, the Examiner concedes that the specification supports Applicants' construction of this term, rather than the Examiner's. (Examiner's Answer at p. 11).

Additionally, this Examiner has evidenced a complete and total lack of understanding of the patent law. This lack of understanding of the patent law is illustrated by the Examiner's failure to have even a rudimentary understanding of § 102(b). The Examiner ignores Applicants' assertion that Herrin et al. ("Herrin") is **not** a proper § 102(b) reference, because it issued less than a year before Applicants' filing date. (See Applicants' Appeal Brief at page 12) Applicants filed the present application on December 12, 1998. As is shown below, Herrin issued on January 13, 1998.



US605706524A

United States Patent	(19)	(11) Patent Number:	5,706,524
Herrin et al.		(43) Date of Patent:	Jan. 13, 1998
(54) DISPOSABLE UNDERGARMENT WAISTBAND AND METHOD OF FORMING SAME		5,135,522 8/1992 Fahreskrog et al.	
		5,187,817 2/1993 Zelzer .....	2,400
		5,190,606 3/1993 Merkawis et al.	
		5,209,891 5/1993 Smith .....	
		5,304,162 4/1994 Kaen .....	604,392
		5,374,262 12/1994 Kaen, Jr. et al. ....	604,387
		5,386,395 2/1995 Kaen et al. ....	
		5,411,498 5/1995 Fahreskrog et al. ....	504,392
		5,421,739 6/1995 Kaen .....	604,391
		5,445,628 8/1995 Gipstein et al. ....	
		5,534,145 9/1996 Rae et al. ....	604,385.2
(76) Inventor: Robert M. Herrin; John Thorpe, both of P.O. Box 3970, Albany, Ga. 31706			
(21) Appl. No.: 699,118			
(22) Filed: Aug. 16, 1996			

Thus, it is beyond dispute that Herrin is not a § 102(b) reference. Nevertheless, the Examiner's Answer continues, without explanation, to maintain the position that Herrin is a § 102(b) reference. Moreover, Herrin is a central reference to the Examiner's positions. The Examiner improperly relies upon Herrin as §102(b) prior art for three separate basis to reject the claims. (See Examiner's Answer at pages 6-10).

Thus, after two appeals, and nearly five years of prosecution, Applicants and the Board are presented with a case where the Examiner has not articulated her theoretical claims construction, concedes that under Applicants' construction the claims are

patentable, and relies, in part, upon a gross misunderstanding of § 102(b) to maintain her rejection of the claims. Accordingly, Applicants respectfully submit that this is a clear case where the Examiner's rejections, arguments and positions are unfounded, are legally and factually erroneous, and should be vacated and reversed by the Board.

### **The “At Least About 85% Claim Limitation”**

The at least about 85% claim limitation calls for a ratio that is expressed as a percentage. The formula for this ratio, including the numerator and denominator, are clearly defined in the specification as:

$$L_{me} \div L_{ee} \times 100 = \text{claimed ratio}$$

Where:

$L_{me}$  is the maximum elongation of the composite structure.

$L_{ee}$  is the elongation of the elastics prior to placement in the composite, i.e., the initial elongation.

100 is required to convert the decimal into a percentage, as called for by the claim.

The support for this claim interpretation is found at page 6, lines 21 – page 7, line 10 of the specification and specifically through the example contained therein, which provides:

For example, a panel made using 1/8 inch (3.2 mm) securement regions, space apart by 1/8 inch (3.2 mm) and having elastic strands placed in under 250% elongation will have a maximum elongation length of about 240%. Thus, this composite would have a maximum elongation of about 96% of the elongation of the elastic material. [page 6, lines 27-31]

Thus, placing the information from this example into the above formula provides:

$$L_{me} \div L_{ee} \times 100 = \text{claimed ratio}$$

$$240 \div 250 \times 100 = 96\%$$

There is no language in the specification or other evidence that would support a different or broader interpretation of this claimed ratio. The Examiner provides absolutely no evidence to dispute Applicants' interpretation.

A claim term must be given its "broadest reasonable interpretation **consistent with** the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000)(bolded added). As set forth above, Applicants' claim interpretation is consistent with, and fully supported by the specification. On the other hand, the Examiner's interpretation of the claimed ratio finds no support in the specification, is inconsistent with the specification, and thus, cannot form the basis for a proper rejection of the claims. The Examiner's interpretation amounts to no more than a theoretical unarticulated construction of the claimed ratio.

At no point in the Answer (or the final rejection) is the Examiner's theoretical construction for the claimed ratio set forth or articulated. At no point does the Examiner identify what the numerator would be in her theoretical construction. At no point does the Examiner identify what the denominator would be in her theoretical construction. And, as set forth below, at no point does the Examiner read the prior art on to her theoretical unarticulated construction.

**Claims 1, 3, 5-9, 15, 17, 18, and 48-50 Are Not Anticipated by Johnson (Reply to Examiner's Answer Basis No. 1)**

The Examiner's Answer does not respond to the issues raised by Applicants' Appeal brief. The Answer does not even attempt to show that each and every element of Applicants claims, as arranged in those claims, is found in Johnson. Thus, the Answer concedes that under Applicants' construction of the claimed ratio Johnson does not anticipate. Moreover, the Answer does not identify what part of Johnson meets the Examiner's theoretical unarticulated construction of the ratio claim element. Thus, even under the Examiner's theoretical unarticulated construction, Johnson does not anticipate.

In fact, the Examiner's Answer appears to be no more than a verbatim restatement of the text from a January 18, 2002 Office Action [Paper No. 23], which was issued long before the filing of Applicants' brief. Moreover, that January 18, 2002 Office Action was addressing claims that are different from those presently before the Board and, in

particular, claims that existed before Applicants amended the claimed ratio in independent claim 1 and added the claimed ratio to independent claim 48.

Applicants' are entitled to a fair and proper examination of their claimed invention. There is no excuse for an Examiner's failure to do so, as evidenced by the Examiner's failure to respond to Applicants' arguments and the restatement of old positions taken with respect to different claims. This conduct by the Examiner, coupled with a lack of understanding of basic patent law, casts substantial doubt over all of the rejections in this case.

**Claims 1, 2, 4, 6-9, 15, 17, and 18 Are Not Anticipated nor rendered Obvious by Smith (Reply to Examiner's Answer Basis No. 2)**

As with Johnson, the Examiner's Answer does not respond to the issues raised by Applicants' Appeal brief regarding the Smith reference. The Answer does not even attempt to show that each and every element of Applicants claims, as arranged in those claims, is found in Smith. In fact, the Answer does not address, let alone refute, the assertion in Applicants' Brief that:

Applicants can find no teaching or suggestion in Smith as to *how much* the elastics strands of the layered material are stretched, or whether there is any correlation between the amount the elastic strands are stretched and the maximum elongation of the layered structure.  
[Applicant's Brief at page 11 (emphasis original)].

Thus, the Answer concedes that under Applicants' construction of the claimed ratio, Smith does not disclose or suggest Applicants' claimed ratio. Moreover, as with the Johnson reference, the Answer does not identify what part of Smith meets the Examiner's theoretical unarticulated construction of the ratio claim element. Even under the Examiner's theoretical unarticulated construction Smith does not anticipate or render the claimed invention obvious.

Furthermore, the Examiner has not articulated the rationale or evidence required to support an assertion that Smith inherently discloses all of Applicants' claimed elements or that Applicants' claimed elements are obvious in view of Smith. The standard for inherency is well established and has not been met by the Examiner:

True “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

MPEP § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)).

Therefore, the complete absence of any teaching or suggestion of the claimed ratio, as set forth in Applicants' Appeal Brief (see pages 10-12) establishes that the claims should be allowed in view of Smith under both §§ 102 and 103.

**Claims 1, 3, and 15-18 Are Not Anticipated nor Rendered Obvious by Herrin et al. (Reply to Examiner's Answer Basis No. 3)**

The Examiner rejected claims 1, 3, and 15-18 as anticipated under 35 U.S.C. § 102(b) or in the alternative, as obvious over Herrin. As with the previous rejections, the Examiner's Answer does not respond to the issues raised by Applicants' Appeal Brief regarding the Herrin reference. The Answer does not even attempt to show that each and every element of Applicants' claims, as arranged in those claims, is found in, or suggested by, Herrin. Moreover, the Answer does not identify what parts of Herrin satisfies the Examiner's theoretical unarticulated claim construction, and in particular, what part of Herrin meets the Examiner's theoretical unarticulated construction of the ratio claim element. Thus, even under the Examiner's theoretical unarticulated construction, the Examiner has failed to establish that Herrin renders the claims unpatentable.

The Examiner's use of Herrin as a § 102(b) reference is incorrect. Herrin issued on January 13, 1998 and the Applicants' application was filed on December 18, 1998. A patent is a proper reference under § 102(b) if:

[T]he invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, ***more than one year*** prior to the date of the application for patent in the United States." (emphasis added).

Herrin issued **less than one year** prior to Applicants' filing date. Therefore, the Examiner's use of this reference is inappropriate and incorrect. Moreover, the Examiner's Answer ignores the fact that this gross error was called to the Examiner's attention in Applicants' Appeal Brief. (See page 12).

Additionally, the Examiner concedes that Herrin does not disclose the ratio claim element – "Herrin does not explicitly teach the limitations the maximum elongation . . . ". (Examiner's Answer, page. 6). Thus, having to concede that Herrin lacks this critical disclosure, the Examiner wanders off into a generic discussion about components, devoid of any relationship to Herrin. The Examiner's wanderings fail to identify any

specific language in Herrin to support her assertions. The Examiner's wanderings also rely upon an unsupported and unfounded "presumption" that the ratio claim element is found in Herrin. This "presumption" is similarly devoid of any support in Herrin. In fact, the Examiner does not even attempt to find support in Herrin for her "presumption." (See Examiner's Answer at pages 6-7). The Examiner's "presumption" is factually and legally erroneous. Clearly, the Examiner's presumption does not meet the legal standard for inherency. MPEP § 2112; *In re Robertson*, 169 F.2d 743, 745 (Fed. Cir. 1999)("[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.").

Similarly, the Examiner's assertion that the claimed ratio element "would obviously have been provided by the process disclosed in Smith" is devoid of any support in Smith and the Examiner does not even attempt to find support in Smith for her assertion. As a matter of law and fact such an unsupported "assertion" by an examiner can not for a proper basis to reject a claim under § 103.

Moreover, the Examiner's reliance on *In re Fitzgerald*, 205 U.S.P.Q. 594 (CCPA 1980), is misplaced. The factual and legal issues addressed in *Fitzgerald* are far removed from those at issue in the present appeal. First, *Fitzgerald* was addressing product-by-process claims and the unique law that applies to those types of claims. *Id.* at 596. Second, the Appellant in *Fitzgerald* admitted that "there [was] no other way to produce the patch-type fasteners defined in the appealed claims except by the use of [the] specific process which is defined in the claims of U.S. Patent 3,784,435 the parent application to the present divisional application." *Id.* at 596. Neither of these key factors is present in Applicant's Appeal. Applicant's claims are not product-by-process claims. Applicants' have repeatedly asserted that nothing in Herrin discloses or suggests Applicants' claimed composition.

Therefore, claims 1, 3, and 15-18 should be allowable over Herrin, under both § 102(b) and §103.

**Claims 1, 2, 4, 6-9, 15, 17, and 18 are Not Obvious Over Smith in view of Vander Wielen (Reply to Examiner's Answer Basis No. 4)**

The Examiner rejected claims 1, 2, 4, 6-9, 15, 17, and 18 as being unpatentable over Smith in view of Vander Wielen under § 103. As with the previous rejections, the Examiner's Answer does not respond to the issues raised by Applicants' Appeal Brief regarding these references. The Answer fails to provide a suggestion or motivation in the art for the combination of these references to obtain a composite material with Applicant's claimed ratio. The Answer does not address or refute the assertion in Applicants' Brief that:

Applicants can find no teaching or suggestion in Smith as to *how much* the elastic strands of the layered material are stretched, or whether there is any correlation between the amount the elastic strands are stretched and the maximum elongation of the layered structure. [Applicant's Brief at page 14 (emphasis added)].

The Examiner's combination is no more than a hindsight attempt to reconstruct Applicant's claimed invention. The Examiner's Answer fails to establish that this hindsight reconstruction has each and every element of Applicants' claims, as arranged in those claims. Furthermore, the Answer does not identify what parts of this reconstruction satisfies the Examiner's theoretical unarticulated claim construction, and in particular, what part of this reconstruction meets the Examiner's theoretical unarticulated construction of the ratio claim element. Even under the Examiner's theoretical unarticulated construction, the Examiner has failed to establish that the combination of these references renders the claims unpatentable.

Additionally as with the Herrin reference, the Examiner concedes that Smith does not disclose the ratio claim element – "Smith does not explicitly teach the limitations the maximum elongation . . . ". (Examiner's Answer, page 7). Thus, having to concede that Smith lacks this critical disclosure, the Examiner again wanders off into a generic discussion about components, devoid of any relationship to Smith or Vander Wielen, the second cited reference used by the Examiner to support her theoretical unarticulated claim construction rejection. The Examiner's wanderings fail to identify any specific language in Smith to support her assertions. The Examiner's wanderings also rely upon an unsupported and unfounded "presumption" that the ratio claim element is found in Smith.

This “presumption” is similarly devoid of any support in Smith. In fact, the Examiner does not even attempt to find support in Smith for her “presumption.” (See Examiner’s Answer at pages 7-8).

Thus, the Examiner’s “presumption” is factually and legally erroneous. Clearly, the Examiner’s presumption does not meet the legal standard for inherency. MPEP § 2112; *In re Robertson*, 169 F.2d 743, 745 (Fed. Cir. 1999) (“[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”). Furthermore, as discussed in the previous section, the Examiner’s reliance on *In re Fitzgerald* to sustain her inherency argument is legally improper.

It is insufficient for the Examiner to rely on a theoretical unarticulated claim construction, without specifically identifying what part of Smith or Vander Wielen meets the Examiner’s theoretical unarticulated construction of the ratio claim element. See *In re Rouffet*, 47 U.S.P.Q. 2d 1453 (Fed. Cir. 1998) ([T]he examiner **must show reasons** that the skilled artisan, confronted with the same problems as the inventor and **with no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed.) (emphasis added). Neither Smith nor Vander Wielen, nor the combination thereof renders the instant invention obvious because neither reference suggests a motivation to combine to obtain a composite material having Applicants’ claimed ratio. Therefore, claims 1, 2, 4, 6-9, 15, 17, and 18 should be allowable over Smith in view of Vander Wielen.

#### **Claims 1, 3, and 5-18 are Not Obvious Over Herrin in view of Vander Weilen (Reply to Examiner’s Answer Basis No. 5)**

The Examiner repeated her previous explanation for rejecting claims 1, 3, and 5-18 as unpatentable over Herrin in view of Vander Wielen without addressing any issues raised by Applicant’s Appeal Brief. (See Examiner’s Answer, page 6). The Answer does not even attempt to provide a suggestion or motivation in the art for the combination of either Herrin or Vander Weilen. The Answer does not even attempt to refute the assertion in Applicants’ Brief that:

Because of the complete absence of any teaching or suggestion of the required claim elements in each of these references, there is no

suggestion to combine them. Moreover, the Examiner has relied on several references in order to support the obviousness rejections of many of the claims, i.e. Smith, Herrin (discussed above) and Vander Wielen. If anything, the need to rely and combine multiple references without any suggestion to combine them supports Applicant's position of non-obviousness. [Applicants' Brief, p. 16]

Thus, the Answer concedes that under Applicant's construction of the claimed ratio, neither Herrin nor Vander Wielen alone or in combination thereof discloses or teach Applicants' claimed ratio. It is improper for the Examiner to sustain her previous rejections by simply restating a previous position taken with respect to different claims and failing to respond to Applicants' Appeal Brief arguments.

The Examiner has not articulated the rationale or evidence required to support an assertion that Herrin inherently discloses all of Applicant's claimed elements or that Applicants' claimed elements are obvious in view of Vander Wielen. The Examiner's assertion that the claimed ratio "would have been obvious to one having ordinary skill in the art to have determined the optimum values of a cause effective variable such as maximum elongation of the composite" is devoid of any support in the Herrin reference and an example of the Examiner's improper hindsight reconstruction of the Applicant's invention. (See Examiner's Answer, p. 9). Therefore, even under the Examiner's theoretical unarticulated construction, the Examiner has failed to establish that the combination of these references renders the claims unpatentable.

Additionally, Herrin is not 102(b) prior art and thus the examiner's reliance upon it is improper.

Therefore, claims 1, 3, and 5-18 should be allowable over Herrin in view of Vander Wielen under § 103.

#### **Claims 2 and 4 Are Not Obvious Over Johnson or Herrin et al. in View of Smith (Reply to Examiner's Answer Basis No. 6)**

The Examiner rejected claims 2 and 4 as being unpatentable over Johnson or Herrin et al. in view of Smith under § 103(a). As discussed in the previous sections, the Answer does not respond to the issues raised by Applicants' Appeal Brief regarding the Johnson or Herrin references. The Answer does not even attempt to show any

motivation or teaching in the references which would render the pending claims obvious. The Examiner does not respond or refute the assertion in Applicants' brief that:

Neither Johnson nor Herrin, nor the combination thereof, renders the instant invention obvious in light of Smith because none of these references teaches or suggests the "maximum elongation of at least about 85% of the elongation of the elastic member" [i.e. the Applicants' claimed ratio] claim feature of dependent claims 2 and 4. [Applicants' Brief at page. 17].

In the Answer, the Examiner concedes that Herrin does not anticipate Independent claim 1 (See Examiner's Answer p. 8). It is well established that "dependent claims include all of the limitations of the claims upon which they depend." 35 U.S.C. § 112, ¶ (2002); 37 C.F.R. § 1.75(c); MPEP 608.01 (i). Claims 2 and 4 are both dependent on Independent claim 1. Therefore, even under the Examiner's theoretical unarticulated construction of the ratio claim element, Herrin does not anticipate or render dependent claims 2 and 4 obvious.

The Answer further concedes that Applicants' construction of the claimed ratio is not disclosed, taught or suggested in either Johnson or Herrin. Although, the Answer introduces a third reference, Smith, as a basis for sustaining the Examiner's § 103(a) obviousness rejection, the Answer does not identify what part of Smith satisfies the Examiner's theoretical unarticulated construction of the ratio claim element. The Examiner's Answer appears to be no more than a verbatim restatement of the text from a January 18, 2002 Office Action [Paper No. 23] which again issued long before the filing of Applicants' brief.

At no point in the Answer (or Final Rejection) is the Examiner's theoretical construction of the claimed ratio set forth or articulated. At no point does the Examiner identify a correlation between the elongation of the elastic strand and the maximum elongation of the composite material comprising that strand as articulated under Applicant's construction of the claimed ratio. At no point does the Examiner read the prior art on to her theoretical unarticulated construction.

Additionally, Herrin is not 102(b) prior art and thus the examiner's reliance upon it is improper.

Accordingly, any rejections of dependent claims 2 and 4 under § 103 should be withdrawn.

**Claims 10-14 and 16 Are Not Obvious Over Johnson in View of Dorbin (Reply to Examiner's Answer Basis No. 7)**

As discussed above, the Examiner's Answer does not respond to the issues raised by Applicants' Appeal brief regarding the Johnson and Dorbin references. The Answer does not even attempt to show that the combination of the references discloses each and every element of Applicants' claims. The Answer concedes that under Applicants' construction of the claimed ratio, Johnson does not anticipate or provide a suggestion to combine with the Dorbin reference. The Answer does not address, let alone refute, the assertion in Applicant's Brief that:

Dorbin provides no teaching on the amount of elongation of the absorbent article or of the elasticized portions thereof. Because of the complete absence of any teaching or suggestion of the required claim elements in each of these references, there is no suggestion to combine them [Applicant's Brief, at page 18]

The Examiner, has once again, failed to establish a motivation or suggestion to combine these references to obtain the composite material having the Applicants' claimed ratio. Instead, the Examiner improperly uses hindsight reconstruction to support her assertions that Applicant's claimed ratio is obvious. The Examiner's Answer does not identify what parts of the Examiner's hindsight reconstruction satisfies the Examiner's theoretical unarticulated claim construction, and in particular, what part of this reconstruction meets the Examiner's theoretical unarticulated construction of the claim element. Moreover, "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason to combine** the teachings of the references (bold emphasis added)." MPEP § 2143.01, *Ex parte Levingood*, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993).

Again, Applicants are entitled to a fair and proper examination of their claimed invention. There is no excuse for the Examiner to simply repeat previous restatements taken with respect to different claims. There is no excuse for the Examiner to dismiss or fail to address Applicant's arguments articulated in its Appeal Brief. At no point in the Answer (or the final rejection) is the Examiner's theoretical construction of the claimed ratio set forth or articulated. It is unfair and improper to require the Applicants to guess which elements of the pending claims the Examiner believes to be disclosed by the cited references. For the reasons succinctly stated above, claims 10-14 and 16 are allowable over Johnson and in view of Dorbin under § 103(a).

## CONCLUSION

Contrary to the Examiner's arguments set forth in the Examiner's Answer, it is respectfully submitted that the cited references do not teach Applicants construction of the claimed ratio or even disclose a structure present in Applicants' claims. The teachings of the Appellants' claimed invention are substantially different to the cited references. None of the cited references provide a suggestion or motivation to combine nor does the combination of the cited references teach each and every element of the Applicants' claims.

Applicants, as inventors and members of the public, are entitled to a thorough examination of their pending claims. The record before this Board, however, indicates that rather than examination applicants have been faced with obfuscation. Throughout this case the Examiner has failed to articulate any rationale basis for denying Applicants a patent.

Accordingly, Appellants respectfully traverse the Examiner's rejection of the pending claims because the present invention is patentable over the cited references. Consequently, the Examiner's rejections should be REVERSED.

Respectfully submitted,



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